

REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

The amendment to claim 7 corrects an obvious typographical error. New claims 25-27 are supported by the third paragraph on page 5 of the specification. New claims 28-30 are supported by the paragraph bridging pages 5-6 of the specification. New claims 31-33 are supported by the examples, which teach composition devoid of any sulfosuccinic acid monoesters. Applicants do not believe that any of the amendments introduce new matter.

The Examiner again rejected claims 7, 12-17 and 19-24 under 35 U.S.C. 102(b) as being anticipated by Mager et al. (JP 09-301834). The Examiner found Mager to exemplify a hair washing agent comprising 1-14% N-acylglutamate and 1-14% sodium lauryl ether sulfate. In response, Applicants have checked the examples and none of them show both the N-acylglutamate and the sodium lauryl ether sulfate. Indeed, it can be seen by the cited abstract that the formulation does *not* have to contain either the N-acylglutamate or sodium lauryl ether sulfate. They are *optional* ingredients. Therefore, the reference teaches a washing agent which comprises:

- a) A half ester of ethoxylated sulfo-succinic acid of formula I and/or N-acylglutamate of formula II
- b) An amphoteric betaine surfactant
- c) Sodium lauryl ether sulfate and/or sodium myristyl ether sulfate and
- d) Cationic cellulose.

Applicants point out the location of “and/or” makes clear that neither sodium lauryl ether sulfate nor N-acylglutamate are necessary components. Thus, for example, the reference includes the following formulation, which does not contain either N-acylglutamate or sodium lauryl ether sulfate:

- a) A half ester of formula I
- b) An amphoteric betaine surfactant
- c) Sodium myristyl ether sulfate and
- d) Cationic cellulose.

Clearly, such formulation does not contain either N-acylglutamate or sodium lauryl ether sulfate. Consequently, it is not the case here that Mager anticipates the instant claims.

The Examiner takes the position the application of the preparation to hair would inherently result in its application to the scalp. Applicants submit this is not necessarily the case, and respectfully request that the Examiner document her position. For many applications, a person is bent over a sink, in a salon for example, where the sole purpose is for the remainder of the body to not be in contact with the shampooing agents. Accordingly, it is possible for hair to be washed without wetting the scalp. Moreover, Applicants submit that the Examiner has not established a *prima facie* case of inherency. As pointed out by the Board of Patent Appeals and Interferences in *Ex parte Levy*, 17 USPQ2d 1461, 1463-1464 (BPAI 1990):

“[T]he initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention rests upon the Examiner. * * * In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic

necessarily flows from the teachings of the applied prior art. [Emphasis in original.]”

Applicants submit that the Examiner has not discharged this initial burden. Since it is possible for the scalp to not be affected, it is also possible that application to hair does not necessarily result in the application to the scalp.

Applicants would point the Examiner to the first paragraph on page 5 of the Office Action. The Examiner discusses the “instantly claimed *product*”. In this, the Examiner confuses the issue as the instant claims are drawn to a *method* and novelty of the method depends on whether the method has been practiced before, i.e., whether anyone has applied the composition to the skin for purposes of preventing or reducing the attachment of lauryl ether sulfate to the skin. As indicated above, it is not necessarily the case that a composition containing lauryl ether sulfate and N-acylamino acids was known based on Mager. Further, in view of Mager even if such compositions were known, it was *not* known whether such compositions were applied to human skin. Consequently, there’s nothing in Mager that would have led a person of ordinary skill in the art to conclude that the instantly claimed method had been inherently practiced in the prior art.

With respect to the issue of inherency, it might be helpful for the Examiner to consider the decision in *In re Shetty*, 195 USPQ 753, 756-757 (CCPA 1977). The claims therein were drawn to a method of curbing appetite in animals by administering to the animals certain adamantane compounds. Certain similar compounds had previously been administered to animals, but for other purposes, i.e., to combat viral infections, to reduce blood sugar content and to treat depression. The Examiner therein reasoned that the claimed method was obvious

because the compounds had previously been administered to animals in the same amount and, thus, the prior art technically taught the method step claimed.

The Court, in response, held that the *purpose* that is to be achieved is a factor to be considered in the obviousness of a claimed method of use. Thus, on pages 756-757, the Court comments:

“The issue here is whether the claimed method of curbing appetite would have been obvious. That appellant’s ‘amount effective to curb appetite’ corresponds to or inheres in Narayanan’s amount ‘to combat microbial infestation’ does not persuade us of the obviousness of appellant’s method. As this court said in *In re Naylor* [citations omitted]:

*[Inherency] is quite immaterial if, as the record establishes here, one of ordinary skill in the art would not appreciate or recognize that inherent result. ****

*** we find nothing in the record which would afford one of ordinary skill reason to anticipate that a trial *** [of the combined prior art teachings] would be successful in producing the polymer recited in the claims.

The Patent Office has failed to show a reasonable expectation, or some predictability, that Brake’s compound *would be an effective appetite suppressant* if administered in the dosage disclosed by Narayanan. The mere hindsight assertion that corresponding dosages render appellant’s method obvious is untenable. *Prior to appellant’s disclosure, none of the adamantane compounds in any of the references suggested a use, much less a dosage, for curbing appetite.*

What we said in *In re Spormann* [again, citations omitted], relative to inherency applies equally here:

As we pointed out in In re Adams [citations omitted], the inherency of an advantage and its obviousness are entirely different questions. That which may be inherent is not necessary known. Obviousness cannot be predicated on what is unknown (emphasis added)."

Given Mager, a person of ordinary skill in the art would have had no knowledge that N-acylamino acids and their salts prevent or reduce the attachment of lauryl ether sulfate during a washing process. Consequently, a person having ordinary skill in the art would not have been motivated by Mager to apply a lauryl ether sulfate in combination with N-acylamino acids and their salts to human skin for the purpose of preventing or reducing the attachment of lauryl ether sulfate to human skin.

The Examiner says the N-acyl amino acid is not optional, but one of three embodiments disclosed by Mager. In response, Applicants submit that the N-acyl amino acid is most certainly optional. The N-acyl amino acid is not mandatory, and Mager's teachings clearly extend to embodiments that do not contain any N-acyl amino acid. Therefore, the N-acyl amino acid is optional. In the same manner, the sodium lauryl ether sulfate is also optional, since it is not mandatory, and Mager's teachings clearly extend to embodiments that do not contain sodium lauryl ether sulfate. Consequently, the question is whether there is any teaching of their combination. Applicants submit that there is absolutely nothing in Mager requiring a combination of N-acyl amino acid and sodium lauryl ether sulfate. Accordingly, the present invention cannot be anticipated by Mager.

In view of the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and to withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

In case this rejection is maintained, Applicants respectfully request that the Examiner give special consideration to new claims 25-33. The limitations of these claims clearly are not anticipated by Mager.

Claims 7, 12-17 and 19-24 were rejected under 35 USC § 103(a) as being obvious over Miyamoto et al. ("Miyamoto"), U.S. Patent No. 4,749,515. In response, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

The Examiner concedes that Miyamoto fails to teach a specific combination of lauryl ether sulfate and N-acylamino. Applicants submit that there is nothing in the Miyamoto that would have led persons skilled in the art to this particular combination. In this regard, there is no teaching or suggestion in Miyamoto that a combination of lauryl ether sulfate and N-acylamino compounds prevents or reduces the attachment of the lauryl ether sulfate to human skin during a washing process (claim 7); or desorbs lauryl ether sulfate from human skin (claim 13); or is to be used for bathing (claim 19). Consequently, Miyamoto cannot make out a *prima facie* case of obviousness against the present claims.

Also, Applicants point to new claims 31-33. The presence of at least one sulfosuccinic acid monoester is a critical aspect of Miyamoto's invention. See column 2, lines 40-43; and column 7, lines 18-30. New claims 31-33 do not embrace sulfosuccinic acid monoesters. Consequently, Miyamoto cannot make out a *prima facie* case of the obviousness of these claims.

In view of the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and to withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

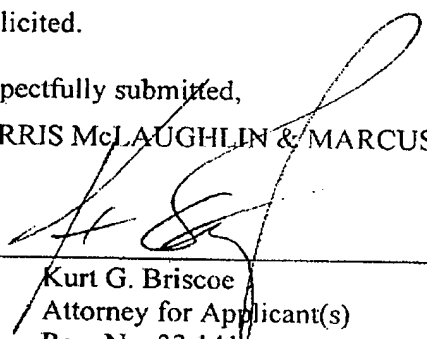
Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants further believe that this application is in condition for immediate allowance. However, should the Examiner determine that any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,
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